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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

VU, T

ART UNIT	PAPER NUMBER
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2152

16

DATE MAILED: 10/31/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

T.R

# Office Action Summary

Application No.

09/098,204

Applicant(s)

Udell et al

Examiner

Thong Vu

Art Unit

2152

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on Aug 20, 2001
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10, 13-15, and 17-47 is/are pending in the application.
- 4a) Of the above, claim(s)          is/are withdrawn from consideration.
- 5) ☐ Claim(s)          is/are allowed.
- 6) ☒ Claim(s) 1-10, 13-15, and 17-47 is/are rejected.
- 7) ☐ Claim(s)          is/are objected to.
- 8) ☐ Claims          are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on          is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on          is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some\* c) ☐ None of:

- ☐ Certified copies of the priority documents have been received.
- ☐ Certified copies of the priority documents have been received in Application No.
- ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s).
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s).          20) ☐ Other:

### DETAILED ACTION

1. This office action is in response to Request for Reconsideration filed on 8/20/2001. Claims 1-10,13-15,17-47 are pending. The rejections cited are as stated below

2. Claims 1-10-13-15,17-47 are rejected under 35 U.S.C. § 103 as being unpatentable over Thorne et al [Thorne 5,958,005] in view of Beck et al [Beck 5,903,723]

3. As per claim 1, Thorne discloses a method for creating a self-destructing document, comprising the steps of creating an executable module which instructs a computer to automatically delete the document to which the executable module is attached when the document, based on a preselected expiration date is expired; attaching the executable module to the document [such as an Email software with the security options including a notice indicating an impending software will be self-destructed, the capability of sender to control the ability of recipient to copy, forward, print and store document, user selects the class of security which it is desired to impose by attach to the document, Thorne col 1 lines 42-col 2 line 55, col 6 lines 22-67, col 7 lines 1-42, col 8 lines 27-42]. Therefore Thorne provides all means necessary to a skilled in the art to create an Email

Thorne also teaches the Private message with the security features such as automatically deleted document after being accessed by the recipient or after a giving time limit or other predetermined events (print, forward, copy, store), notified and user given a warning and option when attempt to process the message as a design choice [Thorne col 8 lines 59-67, col 10 lines 1-62, col 11 lines 5-53, col 12 lines 10-16]. However Thorne fails to explicitly teach the executable code is attached to the email (or document). Beck discloses a Email message with attachment, and encryption and decryption keys, automatically deleted by a time limit [Beck col 7 lines 1-18].

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the email with attachment taught by Beck with Thorne's system. By doing so it would improve the security and reliability on the data processing network.

4. As per claims 2-4, Thorne-Beck disclose the executable module is an executable code, program, macro as program software including Email application [Thorne col 6 lines 22-30]

5. As per claim 5, Thorne-Beck disclose the step of executing the executable module when the document is opened as a design choice of program software [Thorne col 1 lines 42-57, col 6 lines 22-67]

6. Claims 6-10,13-15,17-47 contain the same limitations that were addressed in rejecting claims 1-5 above. By the same rationale applied above, claims 6-10,13-15,17-47 are rejected.

7. Claims 1-10,13-15 are rejected under 35 U.S.C. § 103 as being unpatentable over Ji et al [Ji 5,889,943] in view of MacPhail [4,899,299]

8. As per claim 1, Ji discloses a method for creating a self-destructing document, comprising the steps of creating an executable module which instructs a computer to automatically delete the document to which the executable module is attached, (when the document based on a preselected expiration date is expired); attaching the executable module to the document [Ji abstract col 3 line 55-col 4 line 16, col 18 lines 32-54, col 20 lines 30-40]

However Ji fails to detail when the document based on a preselected expiration date is expired. MacPhail discloses a electronic documents is set for automatically delete by an expiration data [MacPhail abstract, col 2 lines 48-59]. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate the message automatically deleted based on an expiration date as taught by MacPhail into Ji's system in order

to utilize the email message attach by an executable code would automatically delete by an expiration date. By doing so it would improved the reliability of data storage on the network.

9. As per claims 2-4, Ji-MacPhail disclose the executable module is an executable code, program, macro as inherent feature of program code [Ji line col 1 line 62-col 2 line 9]
10. As per claim 5, Ji-MacPhail disclose the step of executing the executable module when the document is opened [Ji line col 1 line 62-col 2 line 9]
11. Claims 6-10,13-15 contain the same limitations that were addressed in rejecting claims 1-5 above. By the same rationale applied above, claims 6-10,13-15,17-47 are rejected.
12. Claims 17-47 are rejected under 35 U.S.C. § 103 as being unpatentable over Ji et al [Ji 5,889,943] in view of MacPhail [4,899,299] and further in view of Shear [5,410,598]
13. As per claim 17, Ji-MacPhail disclose a self-destructing email messaging system comprising an executable module, the executable module configured to instruct a computer to automatically delete an email message to which the executable module is attached when a predetermined condition is met ; an email messaging system, the email messaging system configured to create the message and to transmit the message, the email messaging system attaching the executable module to the message prior to transmission [Ji abstract col 3 line 55-col 4 line 16, col 18 lines 32-54, col 20 lines 30-40][MacPhail abstract, col 2 lines 48-59]

However Ji-MacPhail fail to teach said predetermined condition is selected from the group consisting of an attempt to print, copy, forward the message. Shear taught this well-known technique in the network security art such as a security database system with the encryption and decryption data including the self-destruction option when user attempt to access an unauthorized feature [Shear abstract, col 18 line 55-col 19 line 19]. Therefore, it would have been obvious to

one having ordinary skill in the art at the time the invention was made to incorporate the message automatically deleted based on an attempt to access an unauthorized feature as taught by Shear into Ji-MacPhail system in order to prevent the unauthorized data processing on the network.

14. Claims 18-47 contain the similar limitations that were addressed in rejecting claims 1-17 above. By the same rationale applied above, claims 18-47 are rejected.

15. Claims 1-10,13-15,17-47 are rejected under 35 U.S.C. § 103 as being unpatentable over Hansen [Enhancing documents with embedded programs: How Ness extends insets in the Andrew Toolkit] in view of Beck et al [Beck 5,903,723]

As per claim 1, Hansen discloses a method for creating a self-destructing document, comprising the steps of creating an executable module which instructs a computer to automatically delete the document to which the executable module is attached when the document, based on a preselected expiration date is expired; attaching the executable module to the document [Hansen, page 28 col 2 lines 4-13]

However Hansen fails to detail the a preselected expiration date is expired. Beck discloses a Email message with attachment automatically deleted by a time limit and encryption and decryption keys [Beck col 7 lines 1-18]. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the technique of a email message automatically deleted by an expiration date as taught by Beck and Hansen's system. By doing so it would improve the security and reliability for message storage and transaction between client/server.

16. As per claims 2-4, Hansen-Beck disclose the executable module is an executable code, program, macro as inherent feature of software code [Hansen page 28 col 2 lines 4-13]

17. As per claim 5, Hansen-Beck disclose the step of executing the executable module when the document is opened [Hansen page 28 col 2 lines 4-13]

18. Claims 6-10,13-15,17-47 contain the same limitations that were addressed in rejecting claims 1-5 above. Examiner would take an Official Notice, that the technique self-destruction of data, message, software will be activated whenever user attempt to access an unauthorized feature is well-known in the network security art [see Shear, Thorne references]. By the same rationale applied above, claims 6-10,13-15,17-47 are rejected.

19. Claims 1-10,13-15,17-47 are rejected under 35 U.S.C. § 103 as being unpatentable over Drake [6,006,328] in view of Norin et al [Beck 5,787,247]

20. As per claim 1, Drake discloses a method for creating a self-destructing document, comprising the steps of creating an executable module which instructs a computer to automatically delete the document to which the executable module is attached when the document, based on a preselected expiration date is expired; attaching the executable module to the document [such as a message with a header is attached by a executable code or software which is designed to self-destruct, Drake Fig 10, col 7 lines 43-52]

However Drake fails to detail the a preselected expiration date is expired. Norin discloses a Email message with time-based expiration date wherein an object is older a set time will be deleted automatically [Norin col 24 lines 1-25]. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the technique of a email message automatically delete by an expiration date as taught by Norin and Drake's system. By doing so it would improve the reliability for data storage and transaction between client/server.

21. As per claims 2-4, Drake-Norin disclose the executable module is an executable code,

program, macro as inherent feature of software code [Drake Fig 10, col 7 lines 43-52]

22. As per claim 5, Drake-Norin disclose the step of executing the executable module when the document is opened [Drake Fig 10, col 7 lines 43-52]

23. Claims 6-10,13-15,17-47 contain the same limitations that were addressed in rejecting claims 1-5 above. Examiner would take an Official Notice, that the technique self-destruction of data, message, software will be activated whenever user attempt to access an unauthorized feature is well-known in the network security art [see Shear, Thorne references]. By the same rationale applied above, claims 6-10,13-15,17-47 are rejected.

### ***Response to Arguments***

24. The applicant arguments filed on 08/20/2001 have been fully considered but they are not persuasive to overcome the prior arts

1.A. In response to applicant's argument that the prior art (Thorne-Beck) does not teach creating a self destructing document, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). In this case, Thorne taught the Email with the instruction (or executable module) for erasure (or self-destructing) of the data message but Thorne is silent on the attachment. Beck taught the Email with attachment document with automatically delete feature. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to



combine Thorne and Beck teachings to create a Email including an attachment document with self-destructing feature.

1.B In response to applicant's argument that the virtual container create by the method of claim 20 is not the same as the executable module resulting from claim 1, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In this case, examiner interprets the virtual container as the executable module of macro/instructions/digital code or software which is self destruct as taught by Thorne.

2. In response to applicant's argument that the prior art (Ji-MacPhail) does not teach creating a self destructing document, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In this case, Ji taught email system with a virus analysis and treatment module wherein the virus (executable code for self-destruction) is attached to Email or other program. MacPhail taught the method of deletion an electronic document with an expiration date. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine Ji and MacPhail teaching to create a messaging system with self-destruct module attach to an Email message or embedded to the Email as a design choice.

3. In response to applicant's argument that the prior art (Ji-Macphail-Shear) does not teach creating a self destructing document, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In this case, Ji taught email system with a virus analysis and treatment module wherein the virus (executable code for self-destruction) is attached to Email or other program. MacPhail taught the method of deletion an electronic document with an expiration date. Shear taught the encrypted database and self-destruct feature set by an expiration date. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine Ji-MacPhail-Shear to provide the messaging system the options to create an self-destruct document either by an expiration date or by attachment program such as virus or worm.

4. In response to applicant's argument that the prior art (Hansen-Beck) does not teach creating a self destructing document, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA

1963).

In this case, Hansen taught the multimedia mail wherein the author wants to dynamically create an object or a script which delete a file . And Beck details an email system with attachment. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine Hansen and Beck to provide a messaging system with attachment which could delete or self-destruct as design by author.

5. In response to applicant's argument that the prior art (Drake-Norin) does not teach creating a self destructing document, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

In this case, Drake discloses a method for detecting or preventing Virus, Worm, macro recorders or hacker attack a computer system by hidden or embed or attach the code/program which cause the destruction to the system both hardware, software or the embedded program itself. Norin taught the data object or message is deleted automatically by a set time. Therefore it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine Drake and Norin teaching to provide a messaging system with an automatically deleted or self-destructing feature which attach or embed to an message.

25. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Thong Vu, whose telephone number is (703)-305-4643. The examiner can normally be reached on Monday-Thursday from 8:00AM- 4:30PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, *Mark Rinehart*, can be reached at (703) 305-4815.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patent and Trademarks

Washington, D.C. 20231

or faxed to :           After Final       (703) 746-7238  
                          Official:           (703) 746-7239  
                          Non-Official       (703) 746-7240

Hand-delivered responses should be brought to Crystal Park 11,2121 Crystal Drive, Arlington. VA., Sixth Floor (Receptionist).

*Thong Vu*

*Apri 15, 2001*

  
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